

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte D. STERLING HUBBELL

Appeal No. 94-3990
Application No. 08/038,033¹

ON BRIEF

Before KIMLIN, WARREN and OWENS, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 16-20. Claims 1-13, the other claims remaining in the present

¹ Application for patent filed March 29, 1993. According to appellant, this application is a continuation of Application No. 07/796,154, filed November 22, 1991, now abandoned.

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application, have been withdrawn from consideration. Claim 16 is illustrative:

16. An environmentally safe method of repairing a previously conversion coat solution treated surface using said conversion coat solution and minimizing waste produced in the repair process, wherein said conversion coat solution includes chromic acid and cyanide, comprising the steps of:

providing an applicator having a reservoir and a liquid dispensing tip coupled thereto, said applicator being made from a material which does not react with said conversion coat solution;

disposing an amount of said conversion coat solution in the reservoir;

sealing the reservoir to confine said conversion coat solution therein;

placing the liquid dispensing tip in contact with a desired area of the surface; and

rubbing the tip over the desired area of the surface to dispense a controlled amount of the conversion coat solution onto the desired area;

placing a tip cover over the dispensing tip to prevent inadvertent application of the conversion coat solution;

whereby the conversion coat solution dispensed on the desired area of the surface dries on the surface leaving substantially no wasted solution.

In addition to the admitted state of the prior art found in appellant's specification, the examiner relies upon the following reference as evidence of obviousness:

Brockman

3,688,450

Sep. 5, 1972

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Appellant's claimed invention is directed to a method of repairing, or touching up, a conversion coating comprising chromic acid and cyanide using an applicator, such as "a well-known conventional 'felt tip' type marking pen" (page 2 of specification), to dispense additional conversion coat solution to a damaged, or scratched, initial conversion coating. According to appellant, "[t]he present method minimizes waste and worker exposure to toxic chemicals in the chromate conversion solution" (page 1 of Brief).

Appellant submits at page 2 of the Brief that "[t]he rejected claims stand or fall together." Accordingly, regarding the examiner's rejection of claims 16-20 under 35 U.S.C. § 103, all the appealed claims stand or fall together with claim 16.

Appealed claims 19 and 20 stand rejected under 35 U.S.C. § 112, first paragraph, for being based upon a specification that does not provide original, descriptive support for the claimed subject matter. Claim 19 stands rejected under 35 U.S.C. § 112, second paragraph. In addition, appealed claims 16-20 stand rejected under 35 U.S.C. § 103 as being

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unpatentable over Brockman in view of the admitted state of the prior art.

We consider first the examiner's rejection of claims 19 and 20 under 35 U.S.C. § 112, first paragraph. According to the examiner, there is no descriptive support in the specification for the claim 19 language "a surface which was initially provided with a continuous conversion coating." In the words of the examiner, "it is unclear that the original coating was a 'continuous coating' . . . The original coating could have been put down in a striped form or other pattern, for example" (page 7 of Answer).

It is well settled that the description requirement of 35 U.S.C. § 112 does not require that later-added claim language be described in ipsis verbis in the original disclosure. In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973). The original disclosure only needs to reasonably convey to one of ordinary skill in the art that the inventor had in his/her possession, as of the filing date of the application, the feature defined by the amended claim language. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). In the present case, we

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agree with appellant that his original specification, considered in its entirety, reasonably conveys to one of ordinary skill in the art that the original coating being treated is a continuous one. In particular, in the BACKGROUND section of the specification, appellant relates "it becomes necessary to treat the scratched areas to return the surfaces to a condition of complete chemically treated corrosive protection." (Emphasis added). In our view, one of ordinary skill in the art would find it quite apparent that a complete, continuous conversion coating must be applied in order to effectively protect the substrate against corrosion. Accordingly, we will not sustain the examiner's rejection of claims 19 and 20 under 35 U.S.C. § 112, first paragraph.

We will also not sustain the examiner's rejection of claim 19 under 35 U.S.C. § 112, second paragraph. For the reasons given above, we are satisfied that one of ordinary skill in the art would readily understand the "continuous coating" of claim 19 to be a complete coating which entirely protects the underlying substrate. The test for definiteness under § 112, second paragraph, is not whether the claim language can be construed in a variety of inconsistent ways,

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but what meaning one of ordinary skill in the art would impart to the claim language when it is reasonably read in light of the specification. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Under this standard we do not subscribe to the examiner's position that the skilled artisan would be confused as to whether the term "continuous" could reasonably be interpreted as "the method of application (in a single continuous application process), the appearance of the original coating (not striped or non-uniform in appearance), the smoothness of the original coating (lack of scratches), or something else entirely" (page 8 of Answer).

We also disagree with the examiner that the language "toxic conditions" of claim 19 is vague and indefinite. The ordinary meaning of the term "toxic" is poisonous, and we simply fail to find any indefiniteness in defining a solution comprising chromic acid and cyanide, as well as material in contact with such solution, as toxic. While the examiner explains that "[t]here is no clarification as to how dangerous the material is" (page 8 of Answer), the examiner has not established that one of ordinary skill in the art would have any difficulty in specifically identifying the danger

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associated with handling a solution of chromic acid and cyanide.

We now turn to the rejection of all the appealed claims under 35 U.S.C. § 103 over Brockman in view of the admitted state of the prior art. We will sustain this rejection for essentially those reasons expressed by the examiner in the Answer, and we add the following primarily for emphasis.

Appellant's specification acknowledges, at page 1, that "[t]he conventional method of repairing the scratched aluminum surfaces is to obtain a bottle of certified conversion coat solution, and then using cotton balls, Q-tips, rags, or sponges, and the like, rub, or otherwise apply, the conversion coat solution over the scratched areas until the scratch was fully coated with conversion coat solution." While appellant acknowledges that many conventional application techniques have been used to apply a conversion coat solution, the use of "a well-known conventional 'felt tip' type marking pen or similar structure" (page 2 of specification) for such a purpose is not within the admitted prior art. However, there is no dispute that Brockman discloses an applicator of the type claimed to dispense paint, enamel or other coating

compositions in order to recondition or touch up a surface that received an original coating of the composition.

Accordingly, based on the admitted prior art and Brockman, we fully concur with the examiner that it would have been obvious for one of ordinary skill in the art to employ a conventional "felt tip" type marking pen or similar structure as a substitute for cotton balls, Q-tips, rags, or sponges and the like to recondition or repair a conversion coating solution.

Appellant contends at page 3 of the Brief that "Brockman discloses a tool for touching up paint or enamel." However, the Brockman disclosure is not so limited. Brockman expressly discloses that the reservoir of the dispenser is "for the paint, enamel or other coating composition" (column 3, lines 65 and 66, emphasis added). Brockman also discloses that "[t]he assembly includes replaceable cartridges for containing the desired coating compositions" (column 4, lines 36 and 37), thereby suggesting coating compositions other than paint and enamel.

Appellant also urges at page 6 of the Brief a distinction between the hazardous chromate conversion coating of the present invention and ordinary paint. However, we note that

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many, if not all, paints are toxic, and we are persuaded that one of ordinary skill in the art would have found it obvious to utilize an applicator known for dispensing one toxic material for applying another toxic material. As pointed out by the examiner, appellant bases no argument on objective evidence of nonobviousness, such as unexpected results, nor does appellant contend that one of ordinary skill in the art would have found it unexpected that the applicator of Brockman would be suitable for dispensing a chromate conversion coating solution.

Also, the advantage of not wasting the conversion coat solution described by appellant is also an obvious advantage realized by the applicator of Brockman.

In conclusion, the examiner's rejections under 35 U.S.C. § 112, first and second paragraphs, are reversed. However, based on the foregoing and the reasons well-stated by the examiner, the examiner's rejection of the appealed claims under 35 U.S.C. § 103 is sustained. Accordingly, the examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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